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August 1, 2005

VIA FACSIMILE
EXPEDITED PROCEDURE

To: Examiner Olisa Anwah
Group Art Unit No. 2645
U. S. P. T. O.

Facsimile No. 571-273-8300

From: Phillip E. Miller

Facsimile No. 703-761-2375

Re: Filing of Second Appeal Brief and Petition
U. S. Patent Application Serial No. 09/723,235
Our Ref: YOR229

Dear Examiner:

Enclosed please find a Second Appeal Brief and a Petition under 37 CFR 1.181 for Withdrawal of Notice of Defective Appeal Brief, Entry of After-Final Amendment, and for an Examiner's Answer.


Thank you in advance for your kind consideration of this case.

Very truly yours,


Phillip E. Miller

PEM/lmb
Enclosure

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TRANSMITTAL OF APPEAL BRIEF (Large Entity)					Docket No. YO999-349					
In Re Application Of: Gee-Gwo Mei										
Application No. 09/421,363	Filing Date 10/19/1999	Examiner Anwah, Olisa	Customer No.	Group Art Unit 2645	Confirmation No. 4029					
Invention: SYSTEM AND METHOD FOR PERSONALIZING DIALOGUE MENU FOR AN INTERACTIVE VOICE RESPONSE SYSTEM										
<p style="text-align: center;"><u>COMMISSIONER FOR PATENTS:</u></p> <p>Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on February 16, 2005</p> <p>The fee for filing this Appeal Brief is: <u>\$500.00 (Already Paid)</u></p> <p><input type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 50-0510</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p> Signature</p> <p>Dated: August 1, 2005</p> <p>Phillip E. Miller, Reg. No. 46,060 McGinn & Gibb, PLLC 8321 Old Courthouse Road, Suite 200 Vienna, Virginia 22182-3817 703-761-4100 Customer No. 21254</p> <p>CC:</p> <table border="1"><tr><td>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on</td></tr><tr><td>(Date)</td></tr><tr><td>Signature of Person Mailing Correspondence</td></tr><tr><td>Typed or Printed Name of Person Mailing Correspondence</td></tr></table>							I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on	(Date)	Signature of Person Mailing Correspondence	Typed or Printed Name of Person Mailing Correspondence
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**RECEIVED
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YOR919990349US1**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Gee-Gwo Mei et al.

Serial No.: 09/421,363 Group Art Unit: 2645

Filed: November 19, 1999 Examiner: Olisa Anwah

For: SYSTEM AND METHOD FOR PERSONALIZING DIALOGUE MENU FOR AN
INTERACTIVE VOICE RESPONSE SYSTEMHonorable Commissioner of Patents
Alexandria, VA 22313-1450**APPELLANT'S BRIEF ON APPEAL**

Sir:

This Second Brief on Appeal is filed in response to the Notification of Non-Compliant Appeal Brief dated June 30, 2005 in this Application.

Appellant respectfully appeals the final rejection of claims 1-42 in the Office Action dated November 16, 2004. A Notice of Appeal was filed herein on February 16, 2005.

I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation, assignee of 100% interest of the above-referenced patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, Appellant's legal representative or Assignee which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

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III. STATUS OF CLAIMS

Claims 1-42 are all the claims presently pending in the application and are set forth fully in the attached Appendix. Claims 1-4, 6-8, 10-12, 15-26, 28-32 36, 37 and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Polcyn, et al. (U.S. Patent No. 6,061,433). Claims 13-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Polcyn in view of Csaszar (U.S. Patent No. 5,970,124). Claims 5, 9 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Polcyn in view of Hanson (U.S. Patent No. 6,016,336). Claims 33-35 and 39-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Polcyn in view of Partridge (U.S. Patent No. 5,933,484).

Claim 38 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Polcyn in view of Csaszar, Partridge and Hanson. Claim 41 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Polcyn.

Appellant respectfully appeals these rejections.

IV. STATEMENT OF AFTER-FINAL AMENDMENTS

Appellant notes that an Amendment which canceled claim 11 and substantially incorporated the subject matter of claim 11 into independent claims 1, 16, 26 and 28 was filed on January 28, 2005. However, in an Advisory Action dated February 24, 2005, the Examiner stated that he refused to enter the Amendment because "[t]he proposed amendments raise new issues because they were not recited previously in the pending independent claims".

Appellant respectfully submits that the Amendment filed herein on January 28, 2005 clearly does not "raise new issues" as alleged by the Examiner. In fact, in the January 5, 2004 Office Action the Examiner stated that the limitation of claim 11 is disclosed in Hanson at col. 3, lines 47-48, and in the June 16, 2004 Office Action the Examiner stated that the limitation of claim 11 is disclosed in Polcyn at col. 6. Therefore, it is completely unreasonable for the Examiner now to allege that this feature has not yet been considered by the Examiner.

Therefore, on April 15, 2005, Appellant filed a Second After-Final Amendment which was substantially the same as the January 28th Amendment, to request that the Examiner

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reconsider his unreasonable refusal of entering the January 28th Amendment.

Appellant notes that the Examiner has not responded to the Amendment filed herein on April 15, 2005. Instead, a Notification of Non-Compliant Appeal Brief was mailed on June 30, 2005. This Second Brief on Appeal is filed in response thereto.

Appellant also notes that a Petition under 37 CFR §1.181 to force the entry of the After-final Amendment filed on January 28, 2005 is filed concurrently herewith. Appellant reserves the right to file a supplemental Appeal Brief in order to reflect the claim amendments in the January 28, 2005 Amendment, should the Petition be granted.

V. SUMMARY OF THE INVENTION

The claimed invention (e.g., as recited in independent claim 1), is directed to a method for personalizing an interactive voice response (IVR) system to reduce a number of key sequences to reach a desired source of information. The claimed method includes storing a caller profile, accessing the IVR system via a telephone, and retrieving the caller profile to construct a personalized IVR dialogue menu and play out the personalized IVR dialogue menu via the telephone. The personalized IVR dialogue menu is at least one of based on a caller access pattern and configurable by the caller. The personalized menu includes a plurality of shortcut paths, and an option for changing the plurality of shortcut paths in the personalized IVR dialogue menu (Application at Figures 4 and 5; page 11, lines 17-21).

Another aspect of the claimed invention (e.g., as recited in independent claim 16) is directed to a system for personalizing an interactive voice response (IVR) system to reduce a number of key sequences to reach a desired source of information. The system includes a storage device for storing a caller profile, a telephone for accessing the IVR system, and a retrieval unit for retrieving the caller profile to construct a personalized IVR dialogue menu and play-out the personalized IVR dialogue menu via the telephone. The personalized IVR dialogue menu includes a plurality of shortcut paths, and an option for changing the plurality of shortcut paths in the personalized IVR dialogue menu (Application at Figures 4 and 5; page 11, lines 17-21). Further, the personalized IVR dialogue menu is at least one of based on a caller access pattern

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and configurable by the caller.

Another aspect of the claimed invention (e.g., as recited in independent claim 26) is directed to a system for personalizing an interactive voice response (IVR) system to reduce a number of key sequences to reach a desired source of information. The system includes a storage for storing a caller profile, and a retrieval unit for retrieving the caller's profile to construct a personalized IVR dialogue menu and play-out the personalized menu, the retrieval unit being selectively interfaced with a network and a public switch telephone network (PSTN). The personalized IVR dialogue menu includes a plurality of shortcut paths; and an option for changing the plurality of shortcut paths in the personalized IVR dialogue menu (Application at Figures 4 and 5; page 11, lines 17-21). The retrieval unit includes a telephone interface module for selectively interfacing with the PSTN and for selectively receiving a predetermined tone and a voice input from the caller via the PSTN, the telephone interface module selectively transmitting at least one of synthesized and stored voice messages to the caller via the PSTN. The personalized IVR dialogue menu is configurable by the caller through the PSTN via the telephone interface module. In addition, the retrieval unit further includes a network interface module for communicating with external systems via the network to retrieve information for the IVR system to playback via the telephone interface module, the network interface module presents a configurable menu to the caller via the network for the caller to specify the caller's personalized dialogue menu, and the network interface module parses text messages into a predetermined format such that the parsed text messages are used to interact with the caller through the telephone interface module.

Another aspect of the claimed invention (e.g., as recited in independent claim 28) is directed to a signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform a method for personalizing an interactive voice response (IVR) system to reduce a number of key sequences to reach a desired source of information. The method includes storing a caller profile, accessing the IVR system via a telephone, and retrieving the caller profile to construct a personalized IVR dialogue menu and play out the personalized IVR dialogue menu via the telephone. The personalized IVR

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dialogue menu includes a plurality of shortcut paths; and an option for changing the plurality of shortcut paths in the personalized IVR dialogue menu (Application at Figures 4 and 5; page 11, lines 17-21). The personalized IVR dialogue menu is at least one of based on a caller access pattern and configurable by the caller.

Conventional IVR systems may include a menu which is intended to save a caller's time by allowing the caller to press "1" on a telephone keypad to play out several applications based on the caller's past usage. Such systems may include path (e.g., pressing the number "1" on a telephone keypad) which can be taken by a caller to access applications (e.g., savings account balance, checking account balance, etc.) more directly than an ordinary route (e.g., by a path provided in a standard menu). However, such IVR systems do not include a plurality of shortcut paths.

Moreover, such conventional systems may allow an option for changing the order of presentation of the applications reached by taking a certain path. However, this option is not related to changing a plurality of shortcut paths in the menu of such conventional systems. Indeed, merely changing the order of presentation of applications does not change the "path" that the caller takes to get to those applications. That is, the caller will always take the same path (e.g., pressing the number "1" on a telephone keypad) to get to those applications. Stated another way, the caller may change the order of the applications played out to caller when the caller takes the shortcut path, but the path will always be the same (e.g., pressing the number "1" on a telephone keypad). Thus, such conventional methods/systems, therefore, lack convenience and sophistication (Application at page 11, lines 4-16).

The claimed invention, on the other hand, includes a personalized menu which includes a plurality of shortcut paths, and an option for changing the plurality of shortcut paths in the personalized menu (Application at Figures 4 and 5; page 11, lines 17-21).

For example, in the claimed invention, the menu played out to the caller may state "Press 1 to transfer fund balance by dollar amount, press 2 for account balance by fund" and so on. In this case, for example, the caller may take a first shortcut path (e.g., pressing the number "1" on a telephone keypad) to transfer fund balance, take a second shortcut path (e.g., pressing the number

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"2" on a telephone keypad) to access an account balance, and so on. These "paths" for accessing the information may be more direct than the paths provided ordinarily (e.g., provided in a default main menu). That is, unlike conventional systems, the claimed invention provides a menu which includes a plurality of shortcut paths.

Moreover, the menu in the claimed invention includes an option of changing the plurality of shortcut paths in the menu (e.g., to include different shortcut paths in the menu). Thus, for example, the menu played out to the caller may state "Press 7 to change your personalized menu". The caller may then press "7" on the telephone keypad to change the shortcut paths in the menu such as by adding shortcut paths to the menu or deleting shortcut paths from the menu (Application at page 14 lines 3-8).

These features allow the claimed invention is much more sophisticated, user friendly and flexible than conventional systems.

VI. GROUNDS OF REJECTION TO BE REVIEWED

The grounds of rejection to be reviewed by the Board of Patent Appeals and Interferences include:

- 1) rejection of claims 1-4, 6-8, 10-12, 15-26, 28-32 36, 37 and 42 under 35 U.S.C. § 102(e) over Polcyn, et al. (U.S. Patent No. 6,061,433);
- 2) rejection of claims 13-14 under 35 U.S.C. § 103(a) over Polcyn in view of Csaszar (U.S. Patent No. 5,970,124);
- 3) rejection of claims 5, 9 and 27 under 35 U.S.C. § 103(a) over Polcyn in view of Hanson (U.S. Patent No. 6,016,336);
- 4) rejection of claims 33-35 and 39-40 under 35 U.S.C. § 103(a) over Polcyn in view of Partridge (U.S. Patent No. 5,933,484);
- 5) rejection of claim 38 under 35 U.S.C. § 103(a) over Polcyn in view of Csaszar, Partridge and Hanson; and
- 6) rejection of claim 41 under 35 U.S.C. § 103(a) over Polcyn.

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VIII. ARGUMENT

A. The Rejection of claims 1-4, 6-8, 10-12, 15-26, 28-32 36, 37 and 42 under 35 U.S.C. § 102(e) over Polcyn, et al. (U.S. Patent No. 6,061,433)

As set forth on pages 2-11 of the Office Action dated November 16, 2004, the Examiner rejected claims 1-4, 6-8, 10-12, 15-26, 28-32 36, 37 and 42 under 35 U.S.C. § 102(e) over Polcyn, et al. (U.S. Patent No. 6,061,433), stating:

Regarding claim 1, Polcyn discloses a method for personalizing an interactive voice response (IVR) system to reduce a number of key sequences to reach a desired source of information (col. 2, lines 30-35), comprising:
storing a caller profile (col. 2, lines 40-50);
accessing said IVR system via a telephone (305 from Figure 3); and
retrieving the caller profile to construct a personalized IVR dialogue menu and play out the personalized IVR dialogue menu via said telephone (see Figure 3), said personalized IVR dialogue menu comprising:
a plurality of shortcut paths (321-325 from Figure 3); and
an option for changing said plurality of shortcut paths in said personalized IVR dialogue menu (345 from Figure 3),
wherein said personalized IVR dialogue menu is at least one of based on a caller access pattern and configurable by said caller (345 and 321 from Figure 3)."

The Examiner stated that claims 16, 26 and 28 are rejected for the same reasons as claim 1.

The Examiner rejected the dependent claims by merely citing to portions of the Polcyn reference, as follows: claim 2 (col. 2, line 66 to col. 3, line 10), claim 3 (col. 6, lines 59-64 and Figure 4), claim 4 (col. 2, line 66 to col. 3, line 10), claim 6 (col. 4, lines 34-44), claim 7 (col. 6, lines 59-64), claim 8 (col. 6, lines 59-64), claim 10 (col. 4, lines 15-25), claim 12 (col. 4, lines 34-44), claim 15 (Figure 3), claim 17 (Figure 3), claim 18 (Figure 1), claim 19 (col. 3 and Figure 3), claim 20 (col. 6), claim 21 (col. 2, lines 50-56), claim 22 (col. 4, lines 34-44), claim 23

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(Figure 3), claim 24 (col. 6, lines 59-64), claim 25 (Figures 2 and 3), claim 29 (345 from Figure 3), claim 30 (col. 4, lines 34-44), claim 31 (col. 4, lines 34-44), claim 32 (col. 4, lines 34-44), claim 36 (Figure 3), claim 37 (col. 6, lines 55-65), claim 42 (Figure 3).

1. Independent claim 1

Independent claim 1 recites:

"A method for personalizing an interactive voice response (IVR) system to reduce a number of key sequences to reach a desired source of information, comprising:

storing a caller profile;

accessing said IVR system via a telephone; and

retrieving the caller profile to construct a personalized IVR dialogue menu and play out the personalized IVR dialogue menu via said telephone, said personalized IVR dialogue menu comprising:

a plurality of shortcut paths; and

an option for changing said plurality of shortcut paths in said personalized IVR dialogue menu,

wherein said personalized IVR dialogue menu is at least one of based on a caller access pattern and configurable by said caller"

Appellant respectfully submits that the Examiner's position is flawed as a matter of fact and as a matter of law.

Specifically, Appellant submits that there are elements of the claimed invention that are neither taught or suggested by Polcyn.

In fact, Polcyn does not teach or suggest *"said personalized IVR dialogue menu comprising: a plurality of shortcut paths; and an option for changing said plurality of shortcut paths in said personalized IVR dialogue menu"* as recited in claim 1 and similarly recited in claims 16, 26 and 28.

As noted above, unlike conventional methods and systems, in the claimed invention, the

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menu itself includes the option of changing the plurality of shortcut paths (e.g., the content of the menu) in the menu. These features allow the claimed invention is much more sophisticated, user friendly and flexible than conventional methods/systems (Application at Figures 4 and 6; page 11, lines 17-21).

Clearly, these novel features are not taught or suggested by Polcyn. Indeed, the Examiner attempts to rely on Figure 3 in Polcyn to support his position. However, the Examiner is clearly incorrect.

In fact, nowhere does Figure 3 or anywhere else for that matter, does Polcyn teach or suggest a personalized IVR dialogue menu which includes an option for changing the plurality of shortcut paths. The Examiner surprisingly attempts to equate step 345 in the flowchart of Figure 3 of Polcyn as somehow teaching such an option for changing the plurality of shortcut paths in a personalized IVR dialogue menu. However, the Examiner completely misses the point.

That is, in the claimed invention, the menu itself includes the option of changing the

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